

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action of February 11, 2008, in which the Examiner (1) rejected claims 1, 3, 4, 6-13, 15, 17-24 and 26 under 35 U.S.C. §112, second paragraph, as being indefinite, (2) rejected claims 1, 3, 4, 6, 8-13, 15 and 18-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,933,816 ("**Zeanah**"), in view of U.S. Patent No. 6,349,290 ("**Horowitz**"), U.S. Patent No. 6,622,124 ("**Kolls**"), Michelle Clayton, "New 'share of customer' innovations ("**Clayton**"), and John Mahnke, "Banking MIS challenged to develop next-generation self-service ATMs" ("**Mahnke**"), and (3) rejected claims 7 and 17 under 35 U.S.C. §103(a) as being unpatentable over the prior art as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 6,029,153 ("**Bauchner**").

By the present Amendment, Applicants propose amending independent claims 1 and 12. For example, method claim 1 had been amended to incorporate the limitations of its dependent claims 3, 4, 6 and 7. Similar amendments have been made to apparatus claim 12. Independent claims 24, 25 and 26 have been cancelled. Entry of this Amendment is believed proper since its purpose, in effect, is to merely cancel claims and put the claims in better form for appeal.

To overcome rejection of the claims under 35 U.S.C. §112, the phrase services "not used by a customer" has been removed from the claims.

The Examiner cites new references (**Clay** and **Mahnke**) in rejecting independent claims 1 and 12 under 35 U.S.C. §103(a), combining them with previously cited references (**Zeanah** and **Horowitz**).

Applicants respectfully traverse the rejection.

First, Applicants continue to maintain that **Zeanah** and **Horowitz** are not properly combined to reject claims 1 and 12 (even as presented before the current amendments). The Examiner is required to state a clear articulation of the reason why the claimed invention would have been obvious. **MPEP 2143**. Further, as stated in *KSR Int'l v. Teflex Inc.*, 124 S.Ct. at 1727 (2007), "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated underpinnings to support the legal conclusion of

obviousness." The basis for combining **Zeanah** with **Horowitz** was not stated in the most recent Office Action, and so Applicants have looked to the prior Office action (dated 7/27/07). In that prior Office Action, the Examiner only states that it would be obvious to include "limitations taught by **Horowitz** within **Zeanah** for the motivation of customizing and personalizing the deliver[y] of financial services" (see page 5 of the prior Office Action). Applicants respectfully submit that the Examiner's stated basis for finding obviousness has not met the requirements for making an obviousness rejection, either under the **MPEP** or as required in **KSR**.

In addition, as pointed out in the prior Response, even if the Examiner were to establish a prima facie case of obviousness for combining **Zeanah** with **Horowitz**, Applicant believes **Zeanah** in fact teaches away from the argued combination with **Horowitz**. As mentioned in the prior Response, **Zeanah** has a purpose far different than the present invention, in that it is intended to permit financial transactions to be expanded beyond in-person, bank teller transactions and interactions. Its purpose is to expand current systems to permit transactions to be conducted at remote personal computers and PDAs where there would be no personal, in-person attention to the customer (see, e.g., col. 1, lines 34-45 and col. 3, lines 39-67). Thus, one skilled in the art would not be motivated to combine **Zeanah** and **Horowitz** in order to provide personal, in-person attention and follow-up to promote services to the customer at a bank branch, as in the present invention.

In order to advance prosecution, Applicants have added additional limitations to claims 1 and 12, which clearly distinguish the remaining claims from all of the cited references. For example, claim 1 now includes, among other things, the limitation from claim 7, namely that "the step of transferring customer service information from the central system to the branch system is performed periodically at one or more predetermined times during each day." The Examiner did not specifically discuss this feature in the most recent Office Action, but in the prior Office Action, the Examiner cites **Bauchner** (col. 3, lines 64-67). Applicants point out that among other things, the "updating" referred to in **Bauchner** is the updating of customer profile information, rather than the periodic transfer of customer service information to a bank branch so

that "the ATM displays the customer service information to the customer when conducting a transaction at the ATM," as now recited in claims 1 and 12.

Applicants also point out, in connection with the newly cited **Clay** and **Mahnke** references, that such, references likewise do not disclose or suggest the feature of displaying customer service information at an ATM, as now recited in claims 1 and 12.

Further, neither **Clayton** nor **Mahnke** disclose or suggest many other limitations in independent claims 1 and 12, such as updating customer service information to reflect the reaction of the customer to the "personal, in-person attention" and "the status of any current transaction."

Remaining dependent claims 8-11 and 18-23 each recite limitation in addition to their respective parent claims, and are believed allowable for at least the same reasons as stated above.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Stephen F. Jewett/
Stephen F. Jewett
Reg. No. 27,565

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
SFJ:bhr
61394241 v1